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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,611	02/06/2002	Michael Cleary	CLEARY - 1	6811

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COLLARD & ROE
1077 Northern Boulevard
Rosln, NY 11576

EXAMINER

STAICOVICI, STEFAN

ART UNIT PAPER NUMBER

1732

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/068,611

Applicant(s)

CLEARY, MICHAEL

Examiner

Stefan Staicovici

Art Unit

1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-4 and 8-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attachment

ATTACHMENT TO ADVISORY ACTION

1. Applicant's After-Final Response filed July 20, 2004 has been entered.

Response to Arguments

2. Applicant's remarks filed July 20, 2004 have been considered.

In response to applicant's arguments against the references individually (see page 3 of the After-Final response filed July 20, 2004), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue that "none of the references, either alone or in combination, teach or suggest the process by which precisely marked microparticles may be created by laser etching the sheet and cutting the sheet precisely so that...each particle may be cut precisely so that it contain the entire marking" (see page 4 of the After-Final Response filed July 20, 2004).

In response, it is noted that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As noted throughout prosecution of the instant application:

(a) the primary reference of GB 2 334 347 teaches a process for forming microparticles including, affixing a wafer (substrate sheet) to a support and subjecting said wafer to a wet etching process that *simultaneously divides* said wafer (substrate sheet) into a plurality of microparticles and *also etches holes* through each microparticle (emphasis added), said holes forming an identifiable code and, removing said microparticles from said support;

(b) the secondary reference of Brogger *et al.* ('690) teach the use of a laser to encode symbols on microparticles by ablating (melting/vaporizing the metallic layer) the outer surface of said microparticles to form recesses (see col. 7, lines 15-24);

(c) the secondary reference of Ridinger ('219) teaches a laser etching process that provides a much simpler process than a wet etching process (see Abstract), said laser process using a single laser, hence teaching the laser etching as an *equivalent alternative* to wet etching (emphasis added);

(d) the secondary reference of Stevens ('452) teaches microparticles that include a metallic layer (see col. 3, lines 10-12) coated onto an organic resin substrate (plastic) (see col. 2, lines 53-57) bearing indicia such as alphanumeric (digits) characters (see Abstract and Figure);

Under MPEP §2143.01, "[O]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." In this case, it would have been obvious for one of ordinary skill in the art to

have used a single laser as taught by Brogger *et al.* ('690) to form microparticles in the process of GB 2 334 347 because, Ridinger ('219) specifically teaches that laser etching using a single laser is a much simpler process than wet etching, hence providing for an improved process and also because Brogger *et al.* ('690) specifically teaches the use of a laser in *etching microparticles* as an *equivalent alternative* (emphasis added).

Further, it is noted that Brogger *et al.* ('690) teach laser ablation of indicia (see col. 7, lines 15-16) and Stevens ('452) teaches microparticles bearing indicia such as alphanumeric (digits) characters (see Abstract and Figure). Therefore, it would have been obvious for one of ordinary skill in the art to have provided alphanumeric indicia as taught by Stevens ('452) to the microparticles obtained by the process of GB 2 334 347 in view of Brogger *et al.* ('690) and in further view of Ridinger ('219) because Stevens ('452) specifically teaches that alphanumeric indicia allows for much faster decoding (see col. 1, lines 30-35) and also because, Brogger *et al.* ('690) specifically teaches laser ablation of indicia on the exterior surface of a microparticle, whereas Stevens ('452) teaches that indicia includes both letters and alphanumerics (digits).

Furthermore, it is submitted that the teachings of GB 2 334 347, Brogger *et al.* ('690) and Stevens ('452) are related to similar end products and solve similar problems. As such, under MPEP §2143.01, it is submitted that the motivation to combine the prior art of record is derived from "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art" (See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457- 58 (Fed. Cir. 1998)) because the teachings

of GB 2 334 347, Brogger *et al.* ('690) and Stevens ('452) are related to similar end products and solve the same problem of forming indicia on microparticles.

Applicants argue that the art of record does not teach or suggest, either alone or in combination, "precisely marked microparticles" (see page 4 of the After-Final response filed July 20, 2004). In response, it is noted that GB 2 334 347 specifically teaches microparticles having *predefined dimensions* (precisely marked) because they have physical dimensions after being cut and the process of cutting is a controlled process. As such, it is submitted that a controlled process results in microparticles having controlled (predefined/predetermined) dimensions.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD



Primary Examiner

8/5/04

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August 5, 2004